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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,632	09/15/2003	David Fu	10448	9754
36396	7590	01/27/2006	EXAMINER	
DAVID WEISS 12650 RIVERSIDE DRIVE SUITE 100 NORTH HOLLYWOOD, CA 91607-3442			GREEN, BRIAN	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/662,632	<b>Applicant(s)</b> FU, DAVID	
	<b>Examiner</b> Brian K. Green	<b>Art Unit</b> 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-24, 26-59 and 61-77 is/are pending in the application.
- 4a) Of the above claim(s) 7-11, 20-24, 26-37, 47, 48 and 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13-19, 38-46, 49-59, 61, 63-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

Claims 7-11,20-24,26-37,47,48, and 62 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **with** traverse in the reply filed on Jan. 3, 2005.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6,13-18,38-45,49-58,61, and 63-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neugebauer (U.S. Patent No. 5,522,163) in view of Yeh (U.S. Patent No. 6,256,914) or Yang (U.S. Patent No. 5,167,085).

Neugebauer shows in figures 1-3 a protective display holder comprising a substantially rigid base (24) having a first edge and an opposite second edge, the base including a flat top surface (26) and a recess (48), a substantially rigid cover (14) having a first edge and opposite second edge, the cover including a flat bottom surface (18), retaining means (20,32) adjacent to the first edge of the base and to the first edge of the cover for releasably retaining the bottom surface to the top surface, and a fastener (38) adjacent the second edges of the base and cover for securing the base and cover together. Neugebauer does not disclose using first and second magnetic members to secure the base to the cover adjacent to the second edges. Yeh shows in

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figures 1-4 the idea of embedding magnets (7) within recesses in transparent covers (3-6) for engaging magnets (7) embedded into a base (2) in order to secure each of the covers to the base. Yang shows in figure 2 the idea of embedding a magnetic member (21) within a cover (2) for engaging a magnet (113) embedded in a base (1) for securing the cover and base together. In view of the teachings of Yeh or Yang it would have been obvious to one in the art to modify Neugebauer by replacing the fastener (38) with magnetic members embedded within the cover and base since this would allow the cover and base to be attached together and separated in an easier and faster manner. Neugebauer shows in figures 1 and 3 that the cover includes a recess (46) that receives a protrusion/collar (36) formed on the base. The magnetic members taught by Yang and Yeh would be embedded within the recess in the cover and in the protrusion/collar formed on the base. In regard to claim 2, the cover and base are formed from transparent material. In regard to claim 3, the recess has depth and peripheral dimensions equal to or greater than a respective thickness and peripheral dimensions of the flat item, see column 3, lines 37-39. In regard to claims 5, 53, 65, and 66, Yeh discloses that the magnetic members (7) on the cover and base are magnets. Yang discloses the idea of making the magnetic member on the cover in the form of an iron plate and the magnetic member (113) on the base in the form of a magnet. The substitution of a magnet for the iron plate is considered obvious and well within one skilled in the art and the substitution would create an equivalent fastening structure. In regard to claim 6, Neugebauer shows in figures 1 and 3 that the base includes at least one aperture (32) and at least one projection (20) on the cover. In regard to claims 13, 61, and 72, it would have been obvious to one skilled in the art to place the protrusion/collar on the cover and the recess within the base of Neugebauer since this is a mere reversal of parts and considered an obvious

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expedient, see MPEP 2144.04, VI, A. In regard to claims 16,18,43,45,56,58,69,70,73,74,76, and 77, it would have been obvious to one skilled in the art to make the configuration of the collar and indentation in the shape of an oval (Neugebauer teaches the idea of making the collar and indentation in the shape of a circle) since there is no evidence that the particular shape of the collar and indentation is significant the difference in shape is considered to be a matter of choice which a person of ordinary skill in the art would have found obvious, see MPEP 2144.04, IV, B.

Claims 19,46, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neugebauer (U.S. Patent No. 5,522,163) in view of Yeh (U.S. Patent No. 6,256,914) or Yang (U.S. Patent No. 5,167,085) as applied to claims 18,45, and 49 above and further in view of Cameron (U.S. Patent No. 5,186,566).

Neugebauer in view of Yeh or Yang disclose the applicant's basic inventive concept except for attaching a finger notch along at least one of the second edges. Cameron shows in figures 1-4 first and second panels that include finger notches (42) along the edges of each of the panels. In view of the teachings of Cameron it would have been obvious to one in the art to modify Neugebauer by placing a finger notch along at least one of the second edges since this would allow the cover and base to be separated in an easier and faster manner.

***Response to Arguments***

Applicant's arguments filed Aug. 8, 2005 have been fully considered but they are not persuasive.

The applicant argues that the elimination of the Neugebauer threaded screw and the examiner's "would be" embedment of the Yang or Yeh magnetic members into the Neugebauer cover and base in a manner which he contends would result in applicant's claimed invention comprises non-permissible hindsight reconstruction of applicant's invention. The examiner disagrees since one skilled in the art would recognize that the projection and indentation in the base and cover provide advantages, i.e. an alignment device as well as a means to help prevent the cover from pivoting relative to the base, that improve the overall operability of the device. The replacement of the screw with magnets does not effect the desirability of the projection and indentation. The substitution of the magnets simply provides another more convenient way to attach the cover and base together.

The applicant argues that Neugebauer in view of Yeh or Yang fail to define the specific structure defined in claims 15,42, and 55. The examiner disagrees since when one of the magnets of Yeh or Yang is imbedded in the projection/collar of Neugebauer and the other magnet is imbedded below the indentation of Neugebauer the modified structure would teach/suggest all of the structure defined in claims 15,42, and 55.

The applicant argues that claims 16,18,43,45,56,58,69,70,73,76, and 77 are not an obvious matter of choice since making the collar and indentation non-circular (oval) provides the advantage of preventing the cover from rotating relative to the base. The examiner disagrees since when the projections (20) of Neugebauer are placed in the recesses (32) and the

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projection/collar of Neugebauer is placed within the indentation of Neugebauer the cover can not rotate relative to the base. The shape of the projection and collar are immaterial. The same holds true for the applicant's elected invention shown in figures 1-13.

***Response to Amendment***

The declaration of Kevin P. Higgins under 37 CFR 1.132 filed Aug. 4, 2005 is insufficient to overcome the rejection of claims 1-6,13-19,38-46,49-59,61, and 63-77 based upon the 103 rejections as set forth in the last Office action because: The evidence provides no data whether the amount of sales of the product sold represents a substantial share in the market. The court has noted in the past that evidence related solely to the number of units sold provides a very weak showing of commercial success, if any. See *In re Huang*, 100 F.3d 135, 137, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). Further, the declaration fails to show that the sales were the direct result of the unique characteristics of the claimed invention, as opposed to other economic and commercial factors unrelated to the quality of the claimed subject matter. See *Cable Elec.*, 770, F.2d at 1027, 226 USPQ at 888. In other words, a nexus is required between the sales and the merits of the claimed invention. Merely showing that there was commercial success of an article which embodied the invention is not sufficient. See *Ex parte Remark*, 15 USPQ2d 1498, 1502-03 (Bd. Pat. App. & Inter. 1990).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
BRIAN K. GREEN  
PRIMARY EXAMINER

Bkg  
Jan. 23, 2006